



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                  | CONFIRMATION NO.            |
|---|-------------|----------------------|--------------------------------------|-----------------------------|
| 10/635,665  | 08/07/2003  | Hiraku Murayama      | 029650-144                           | 8895                        |
| 21839 7590 10/01/2007<br>BUCHANAN, INGERSOLL & ROONEY PC<br>POST OFFICE BOX 1404<br>ALEXANDRIA, VA 22313-1404 |             |                      | EXAMINER<br>HOEKSTRA, JEFFREY GERBEN |                             |
|   |             |                      | ART UNIT<br>3736                     | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>10/01/2007      | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

10/635,665

Applicant(s)

MURAYAMA ET AL.

Examiner

Jeffrey G. Hoekstra

Art Unit

3736

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-3, 12-21 and 23-28.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

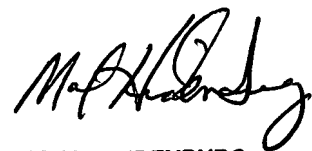
11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues and requests clarification with respect to (a) the anticipatory rejection of at least claims 1 and 28 under Uchino and (b) the obviousness rejection of at least claim 24 under Uchino in view of Palermo, as set forth in the Final Office Action mailed 05/24/2007.

For (a), Applicant argues Uchino does not disclose that the first wire (112,66,81) and the second wire (A,61) are joined to each other by welding. As a preliminary matter, the Examiner notes first that as claimed the first and second wires being joined by welding is a recitation of the intended use and/or intended method of making the guidewire of at least claim 1, wherein the plurality of wires as disclosed by Uchino are capable of being "joined to each other by welding". Moreover, with regards to the clarification of Uchino's disclosure of welding said first and second wires, the Examiner notes Uchino discloses, teaches, and shows methods of making guidewires including attaching and/or joining wires together (column 7 lines 19-29, column 8 lines 16-21, column 15 lines 36-63) wherein the wires being joined or attached are said first and second wire (column 1 lines 34-39, column 6 lines 5-12, column 12 lines 26-33, column 15 lines 36-63).

For (b), Applicant argues it is unclear how the teachings of Palermo are being adapted for use in Uchino. The Examiner notes Palermo teaches a guidewire wherein a welded portion (128) between a first wire (126) and a second wire (106) is located on a distal side of a proximal end of a spiral coil (132), as best seen in Figures 5A and 5B. Both Uchino and Palermo disclose, teach, and are concerned with configuring the mechanical flexibility of a guidewire along its longitudinal length and contemplate doing so by using varying materials of construction, connection methods, and multiple wires to comprise the guidewire length. The Examiner relies upon the additional structure (i.e. the disposed spiral wire and its welded portion) taught by Palermo to remedy the deficiencies of Uchino. The device of Palermo is not being adapted for use in Uchino, but serves as additional structure for the basis of the rejection. The Examiner also notes that the addition of the known options of Palermo's structure to the device as taught by Uchino is obvious to one skilled in the medical device art because the structure as taught by Palermo could have been combined with the structure as taught by Uchino to yield the predictable results of configuring the mechanical flexibility of a guidewire for traversing the tortuous vasculature of a patient with increased ease of operability.



MAX E. WINDENBURG  
PATENT EXAMINER  
PO BOX CENTER 3700